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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,928	12/26/2001	Mamoru Uchida	35.C16066	7419
5514	7590	11/05/2003		
FITZPATRICK CELLA HARPER & SCINTO				
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			EXAMINER	
			LEE, PATRICK J	
ART UNIT		PAPER NUMBER		
2878				

DATE MAILED: 11/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/025,928

Applicant(s)

UCHIDA, MAMORU

Examiner

Patrick J. Lee

Art Unit

2878

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-35 is/are pending in the application.
- 4a) Of the above claim(s) 27-35 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-26 is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5 and 6 is/are rejected.
- 7) ☒ Claim(s) 2 and 7-9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 18 August 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. This action is in response to amendment filed 8/18/2003.

***Drawings***

2. The drawings were received on 8/18/2003. These drawings are acceptable.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1 & 3 are rejected under 35 U.S.C. 102(e) as being anticipated by Shirakawa et al 6,499,889 B1.

With respect to claims 1 & 3, Shirakawa et al disclose a device for an optical connector comprising a light-emitting and light-receiving module. The light-receiving module (7) comprises a light-receiving element embedded within a molded portion (51)

made of a transparent material capable of transmitting light (see column 8, lines 30-38). The molded portion (51) serves as a two-dimensional optical waveguide layer allowing the embedded light-receiving element to receive light propagating within a plane of the molding without any directional dependence in that it can receive light from different angles and either from the front or back of the light-receiving module.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shirakawa et al 6,499,889 B1.

Shirakawa et al disclose the system described in claim 1. With respect to claims 5-6, the use of a spherical device for the light receiving device is known and would have been a mere matter of obvious design choice as such a modification would allow light to be received from a plurality of directions.

***Allowable Subject Matter***

7. Claims 2, 7-9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Claims 10-26 are allowable over the prior art.

9. The following is a statement of reasons for the indication of allowable subject matter:

With respect to claim 2, Shirakawa et al disclose a set of electrical leads (50) instead of an electric wiring layer stacked on the optical transmission region. Such a modification would not have been obvious to one of ordinary skill in the art. As a result, claim 2 and dependent claims 8-9 are objected to.

With respect to claim 7, Shirakawa et al disclose a light-emitting element as part of light-emitting module (6) to be disposed within molding (49) similar to that of molding (51). However, the light-emitting element and light-receiving element are not disposed within the same optical waveguide and such a modification would have changed the nature of the device by Shirakawa et al. As a result, claim 7 is objected to.

With respect to claims 10-17, Shirakawa et al do not disclose the electric wiring layer in similar fashion to claim 2. As a result, independent claim 10 and dependent claims 11-17 are allowable over the prior art.

With respect to claims 18-26, the prior art of record does not disclose the integration of the elements onto a spherical substrate. Such reasoning was stated in a previous office action.

#### ***Response to Arguments***

10. Applicant's arguments with respect to claims 1-3 & 5-9 have been considered but are moot in view of the new ground(s) of rejection.

11. Applicant's election with traverse of optoelectronic device in Paper No. 7 is acknowledged. The traversal is on the ground(s) that the grouping of claims 27-35 is

still a product claim because it defined by the process it is made. This is not found persuasive because, with respect to claims 27-35, this grouping of claims deals with the manufacturing of the device, as stated by the formation of the device in lines 3-5 of claim 27 via exposure, flatting, and the stacking of a film. It is possible for this device to be formed by different methods such as etching the planes or chemical vapor deposition for the multi-layer film. This grouping of claims does not pertain to the ability of the device to sense light. As a result, the restriction requirement is maintained.

12. This application contains claims 27-35 drawn to an invention nonelected with traverse in Paper No. 7. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

#### ***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Furuyama 6,514,104 B1 discloses an optical wiring device.

Tamura et al 6,611,000 B2 disclose a lighting device in which a plurality of light emitting elements and a photodetector are embedded within a transparent layer.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick J. Lee whose telephone number is (703) 305-3871. The examiner can normally be reached on Monday through Friday, 8:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David P. Porta can be reached on (703) 308-4852. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

Patrick J. Lee  
Examiner  
Art Unit 2878

PJL  
October 31<sup>st</sup>, 2003

  
DAVID PORTA  
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